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Erwin B. Bellers

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NXP, B.V.

NXP INTELLECTUAL PROPERTY & LICENSING

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERWIN B. BELLERS

Application No. 09/966,038
Technology Center 2600

Mailed: June 24, 2009

Before PAMELA S. BENNETT, *Review Team Paralegal*.
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 22, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated October 16, 2008. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2-4 of the Appeal Brief filed October 16, 2008 is deficient because it does not separately map independent claims 1, 8 and 15 to the specification by page and line number. The Summary of Claimed Subject Matter appears to be mapped to the published patent application and not to the specification. Correction is required.

Section § 1205.03 of the *Manual of Patent Examining Procedure* (MPEP) Eighth Edition, Rev. 6, September 2007) states in part:

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed January 23, 2009 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also* MPEP §§ 1207.02 and 1207.03 for details.

A review of the Examiner's Answer finds a new Ground of Rejection that has not been provided the required heading "New Grounds of Rejection" and/or which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth a rejection of claims 6, 13 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Page (US Patent No. 4,755,795) in view of Kelly et al. (U.S. Patent No. 6,473,008 B2); whereas the last Office action (Final Rejection mailed July 17, 2007), including any mailed Advisory Actions, sets forth the rejection of claims 6, 13 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Page (US Patent No. 4,755,795). Correction of all Grounds of rejection for all claims is required.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed October 16, 2008 defective, as required by 37 CFR § 41.37(d);
- 2) to notify the Appellant to submit a "paper" which corrects the Appeal Brief's Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v);
- 3) to acknowledge and consider any "paper" submitted by Appellant to correct the Appeal Brief;
- 4) to vacate the Examiner's Answer mailed January 23, 2009;

5) to generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;

6) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection);¹ and

7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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¹ In Technology Center 2600, only the Director, Special Program Examiner or Quality Assurance Specialist may approve new grounds of rejection.